

REMARKS

Reconsideration and removal of the grounds for rejection are respectfully requested. Claims 1-10 were in the application, claims 1-5 have been amended, claim 6 has been cancelled and claims 7-10 have been withdrawn in response to a restriction requirement.

Claims 1-6 were rejected as being indefinite, as claim 1 lacked antecedent basis for "the wings". This has been amended, and the rejection is believed to be moot.

Claims 1-4 and 6 were rejected under 35 USC 103(a) as being obvious over Riddell in view of Sato.

In order to uphold a finding of obviousness, there must be some teaching, suggestion or incentive for doing what the applicant has done. ACS Hospital Systs. Inc. v. Montefiori Hospital, 723 F.2d 1572 (Fed. Cir. 1984). "Both the suggestion and the expectation of success must be found in the prior art, not in the applicant's disclosure." In re Dow Chemical Co., 837 F.2d 469 (Fed. Cir. 1988).

To establish a prima facie case of obviousness based on a combination of references, there must be some teaching, suggestion or motivation in the prior art to make the specific combination that was made by the applicant. In re Raynes, 7 F.3d 1037, 1039, 28 U.S.P.Q.2d 1630, 1631 (Fed. Cir. 1993); In re Oetiker, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1445 (Fed. Cir. 1992). Obviousness can not be established by hindsight combination to produce the claimed invention. In re Gorman, 933 F.2d 982, 986, 18 U.S.P.Q.2d 1885, 1888 (Fed. Cir. 1991). As discussed in Interconnect Planning Corp. v. Feil, 774 F.2d 1132, 1143, 227 U.S.P.Q. 543, 551 (Fed. Cir. 1985), it is the prior art itself, and not the applicant's achievement, that must establish the obviousness of the combination.

The applicants' invention is a package consisting of at least three vertical layers of rolls, the rolls being in rows, which are packaged with a sheet that is wrapped around the group of rolls. Thus, the package is complete when the rolls and sheet are assembled.

Riddell shows only two roll layers, each layer assembled and held in a display tray, the trays joined together to form an assembly over which a sheet of craft paper is wrapped. There is no teaching or suggestion as to how one would assemble three layers together, and further provide a package containing rolls without such supporting trays to maintain an organized roll assembly.

Sato merely discusses wrapping film for articles, but has no teaching or suggestion for the production of a group of rolls as described in claim 1, and the combination with Riddell would merely result in substituting the wrapping sheet for the kraft paper wrapping, teaching nothing as to a package consisting of at least three vertical layers and a wrapping sheet.

As there is no teaching or suggestion for the package of the present invention, claims 1-4 are not rendered obvious by the proposed combination.

Claim 5 was rejected as being obvious over the prior art discussed above relative to claim 1, and further in view of Dearwester. Claim 5 depends from and contains all the limitations of claim 1 therein. While Dearwester discusses pressing and constraining various rolls, there is no teaching or suggestion for a package consisting of a group of rolls in at least three vertical layers of rolls, and a sheet. Consequently, adding Dearwester to the other prior art would fail to teach or suggest the invention to one skilled in the art.

It is important to recognize that packaging multiple loose rolls has many inherent

problems in maintaining the organization of the rolls, as well as in the machines designed to prepare such packages. It is no accident that two layer packages are known, yet three or more layer packages are not. The complexity increases significantly when such additional vertical layers of rows of rolls are contemplated, as the rolls can shift and move. The applicants' invention achieves just such a package, and one skilled in the art would be surprised that this could be achieved without the use of trays or other supporting or aligning means. Consequently, the claimed invention is believed to be patentable over the prior art.

Based on the above amendments and remarks, favorable consideration and allowance of the application are respectfully requested. However should the examiner believe that direct contact with the applicant's attorney would advance the prosecution of the application, the examiner is invited to telephone the undersigned at the number given below.

Respectfully submitted,



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